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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,295	07/17/2003	Joel A. Drewes	MI22-2342	7253
21567	7590	03/02/2005	EXAMINER	
WELLS ST. JOHN P.S. 601 W. FIRST AVENUE, SUITE 1300 SPOKANE, WA 99201				KIELIN, ERIK J
			ART UNIT	PAPER NUMBER
			2813	

DATE MAILED: 03/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/622,295	DREWES, JOEL A.
	Examiner	Art Unit
	Erik Kielin	2813

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1)  Responsive to communication(s) filed on 13 December 2004.
- 2a)  This action is FINAL.                            2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4)  Claim(s) 1-11 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) \_\_\_\_\_ is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) 1-11 are subject to restriction and/or election requirement.

#### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All    b)  Some \* c)  None of:
    1.  Certified copies of the priority documents have been received.
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

## DETAILED ACTION

Applicant has contended that claims 1 through 3 are generic. They are not. MPEP 806.04(c) states that subcombinations are not generic to combinations using them. Furthermore, MPEP 806.04(d) provides the definition of a generic claim. In pertinent part, MPEP 806.04(d) states,

“In an application presenting three species illustrated, for example, in Figures 1, 2, and 3, respectively, a generic claim should read on each of these views; but the fact that a claim does so read is not conclusive that it is generic. It may define only an element or **subcombination** common to the several species.”

As considered with 806.04(c), then, claims 1-3 each fail to meet the definition of a generic claim for at least this one reason. Applicant is referred to MPEP 806.04(d) for additional reasons.

In this regard, there exists no requirement for the “mass” of claim 1 to be a magnetic memory bit. Applicant admits, as stated in the instant specification in the first five paragraphs under the section entitled, “Detailed Description of the Invention” that the mass is not limited to a magnetic memory bit. Therefore Applicant admits that the mass may be other things, but without indicating what these other things might be. **This breadth of claim makes searching virtually limitless as to art searched and thereby exceedingly burdensome.** Accordingly, a single identity of mass and semiconductor construction must be elected so that the Office knows what Applicant is claiming as the invention.

Given Applicant's response filed 13 December 2004 to the Restriction Requirement filed 2 December 2004, including the cancellation of claims 11-54, the restriction requirement may be made as follows.

***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

**One from each of the following lettered groups A through G must also be elected:**

**A. Number of layers over mass or block:**

- A-1. two layers
- A-2. three layers

**B. First layer material**

- B-1. silicon dioxide
- B-2. silicon nitride
- B-3. silicon oxynitride
- B-4. silicon carbide
- B-5. silicon
- B-6. carbon

**C. Second layer material**

- C-1. silicon dioxide
- C-2. silicon nitride
- C-3. silicon oxynitride
- C-4. silicon carbide
- C-5. silicon
- C-6. carbon

**D. Third layer material (only applicable if A-2 is elected)**

- D-1. silicon dioxide
- D-2. silicon nitride
- D-3. silicon oxynitride
- D-4. silicon carbide
- D-5. silicon
- D-6. carbon

**E. Metal in channel**

- E-1. nickel
- E-2. iron
- E-3. copper

**F. Number of materials in channel**

- F-1. one
- F-2. two

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F-3. three

G. Identity of mass and semiconductor construction

- G-1. Mass is an insulator and construction is multi-layered dielectric
- G-2. Mass is a conductor and construction is a multi-level metallization
- G-3. Mass is a conductor and construction is a gate of a transistor
- G-4. Mass is a conductor and construction is a capacitor
- G-5. Mass is a conductor and construction is an inductor
- G-6. Mass is a semiconductor and construction is a resistor
- G-7. Mass is a stack of magnetic material/non-magnetic conductor/magnetic material and construction is an GMR
- G-8. Mass is a stack of magnetic material/ non-magnetic insulator/magnetic material and construction is an TMR
- G-9. Mass is a some other material and construction something else

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic. See MPEP 804.04(c) and 806.04(d) for that which a generic claim is and is not.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erik Kielin whose telephone number is 571-272-1693. The examiner can normally be reached from 9:00 - 19:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Whitehead, Jr. can be reached on 571-272-1702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Erik Kielin  
Primary Examiner  
February 28, 2005